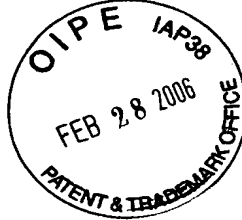


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of
KAY, et al.

Serial No. 09/704,796

Filed: November 3, 2000



: Group Art Unit:
: 2685
:
: Examiner:
: Charles C. Chow
: **EXPEDITED**
: **PROCESSING**
: **REQUESTED**

For: TELEVISION COMMERCE SYSTEM WITH PROGRAM IDENTIFIERS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP BOX AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 28, 2006

Sir:

Applicant hereby requests review of the final rejection of claims 1, 2, 6-8, 17-18, 21-23, 33-34, 38 and 44 in the above-identified application, as set forth in the Final Official Action issued on **November 30, 2005**, which is responsive to an Amendment filed on **October 6, 2005**.

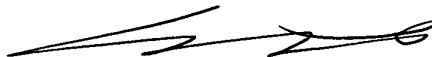
No Amendment is filed with this Request.

A Notice of Appeal is filed concurrently herewith.

The review of the legal and factual basis of the prior art rejections set forth in the above referenced Final Official Action is requested for the reasons stated on the attached five (5) sheets.

I am attorney acting under 37 CFR §1.34.

Respectfully Submitted,
ANTONELLI, TERRY STOUT AND KRAUS

A handwritten signature in black ink, appearing to read 'Alfred A. Stadnicki', with a stylized flourish at the end.

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Submittal of Reasons for Requesting Pre-Appeal Brief Review of the Rejection of the Claims in the Final Official Action issued in U. S. Patent Application Serial No. 09/704,796 on November 30, 2005

Claims 1-47 are pending in this application. Claims 1, 17 and 33 are independent.

Claims 1-33 and 35-47 stand rejected under 35 USC §103(a) as obvious over Knee, et al. (U.S. Patent No. 5,589,892) in view of Yurt et al. (U.S. Patent Pub No. 2004/0049792). Claim 34 stands rejected under 35 USC §103(a) as obvious over the base combination in further view of Voyticky, et al. (U.S. Patent No. 6,438,751).

TRAVERSAL ARGUMENTS PRESENTED IN THE RESPONSE TO THE PRIOR OFFICIAL ACTION AND WHICH REMAIN RELEVANT TO THE REJECTIONS APPEAR TO HAVE BEEN IGNORED

It is initially noted that, as understood, the Examiner's sole response to the arguments presented on pages 11-17 of the Amendment filed on October 6, 2005 appear on in 15 lines on pages 19 and 20 of the final Official Action. It is perhaps worthwhile to note in this regard that the arguments presented in the Amendment relate to limitations recited not only in independent claims 1, 17 and 33, but also to limitations in dependent claims 2, and 6-8, and corresponding limitations recited in the other dependent claims. However, claims 2, and 6-8 are not even addressed in the "Response to Arguments". Furthermore, while the presented arguments raise various issues relating to what appear to be misinterpretations of Knee, and indeed to positions asserted in support of the rejections which are inconsistent with Knee's own explicit teachings, none of these issues are addressed in the final Official Action.

**NO PRIMA FACIE BASIS FOR THE PRIOR ART REJECTION OF CLAIMS IS
ESTABLISHED BECAUSE THE REJECTIONS ARE NOT SUPPORTED BY
THE APPLIED PRIOR ART**

Independent claims 1, 17 and 33

Independent claim 1 requires, inter alia, a plurality of user stations, each configured (i) to receive broadcast information that includes video programming and a plurality of program identifiers, each of which is uniquely associated with a segment of the video programming, and (ii) to transmit a first product related request including the one unique identifier corresponding to the programming segment to which the first product request relates.

The Examiner relies Knee as disclosing such user stations. More particularly, the Examiner asserts that Knee's disclosure relating to the selection of programs from an electronic program guide (EPG) discloses user stations having the required functionality.

However, Knee itself distinguishes the disclosed EPG from programming, and accordingly the EPG does not, according to Knee itself, correspond to the programming required by claim 1.

Furthermore, Knee explicitly describes, in column 40, line 42, through column 41, line 33, with reference Figure 47, an embodiment of the invention which is directed to providing the user with the ability to order a product or service relating to programming (e.g., an advertisement) currently being viewed by a viewer. As explicitly disclosed in column 40, lines 42-61, to facilitate such ordering, a second receiver 30 is required to receive data from which the micro-controller 16 can determine whether the currently tuned to channel is displaying programming for which a product or service is available. If the determination is positive, a product availability icon is overlaid on the currently received television signal containing the programming.

Most importantly however, as further described in column 41, lines 19-30, if the viewer orders the product or service, rather than the user station transmitting a product related request including a unique identifier (i) corresponding to the programming segment (e.g., an advertisement) to which the

product request relates and (ii) which had been received via the broadcast along with the programming, according to Knee the user station transmits either (i) the time and an identifier of the channel being viewed or (ii) product identification information that, as best understood, is extracted from the availability data received by the second receiver (and not with the programming).

It is perhaps also worthwhile to highlight that while the Examiner, on page 2 of the final Official Action, asserts that Knee's icon corresponds to the claimed "unique identifier", the Examiner fails to identify any disclosure within Knee that teaches or suggests that the icon is transmitted from the user's station in a product related request corresponding to the programming segment (e.g., an advertisement) to which the product request relates.

In summary, the Examiner has failed to identify any disclosure within the applied prior art of a user station capable of receiving broadcast information that includes video programming and a plurality of program identifiers (each uniquely associated with a segment of the video programming), and transmits a product related request including the unique identifier corresponding to the programming segment to which that product request relates.

Independent claim 17 requires, inter alia, broadcasting, over the broadcast system, information including video programming and a plurality of programming identifiers, each of which is uniquely associated with a segment of the video programming, and receiving, via the broadcast system, a first product request including the one unique identifier corresponding to the programming segment to which the first product request relates.

Accordingly, claim 17 is distinguishable for reasons that are believe to be clear from the above discussion.

Independent claim 33 requires, inter alia, a tuner configured to tune to any one of multiple broadcast video channels to receive broadcast information, including video programming and a plurality of programming identifiers, each program identifier being uniquely associated with a segment of the video programming,

a display screen configured to display the video programming, and

a processor configured to generate a product request including the one unique identifier corresponding to the programming segment to which the product request relates.

Accordingly, claim 33 is also distinguishable for reasons that are believe to be clear from the above discussion.

Each of independent claims 1, 17 and 33 also requires, inter alia, that the broadcast information, including the video programming and the plurality of program identifiers, be received in a signal, with each program identifier encoded in a portion of the signal that represents the segment of the video programming with which that program identifier is uniquely associated.

As best understood, the Examiner points to paragraphs 1, 13-14 and 29 of Yurt as disclosing broadcast information, which includes the video programming and the plurality of program identifiers, being received in a signal with each program identifier encoded in a portion of the signal that represents the segment of the video programming with which that program identifier is uniquely associated.

However, the disclosures in the referenced paragraphs appear to lack any disclosure related where, within a signal, Yurt's unique identifier is encoded, let alone a disclosure that the unique identifier is encoded in a portion of a signal that represents a segment of the video programming with which that program identifier is uniquely associated.

Indeed paragraphs 1 and 29 do not even discuss unique identifiers. The summary of invention included in paragraphs 13-14, as best understood, relates only to storage and retrieval of encoded information (see Yurt's detailed disclosure in paragraphs 43-44) and lacks any suggestion video programming should or even could be broadcast to a user station in a signal with each identifier encoded in a portion of the signal that represents the segment of the video programming with which that identifier is uniquely associated. However, even if such a disclosure were to be found in Yurt, the reference would still lack any teaching or suggestion that such a transmitted identifier should or could be included in a transmitted product related request which itself relates to the

programming segment represented by the signal in which the unique identifier was encoded.

Selected Dependent Claims

It is further respectfully submitted that no prima facie case has been established for the rejection of at least the following dependent claims for, *inter alia*, the reasons indicated below.

Regarding dependent claims 2, 18 and 34, please see pages 14-16 of the Remarks submitted with the Amendment filed on October 6, 2005.

Regarding dependent claim 6, 21 and 44, please see the pages 16-17 of the Remarks submitted with the Amendment filed on October 6, 2005.

Regarding dependent claims 7 and 22, please see page 17 of the Remarks submitted with the Amendment filed on October 6, 2005.

Regarding dependent claims 8, 23 and 38, please see please see page 17 of the Remarks submitted with the Amendment filed on October 6, 2005.

In view of the misinterpretation of the applied prior art, explicitly recited claim limitations have been effectively ignored, and at best the rejection is based on an improper hindsight reconstruction of the invention based on the present applications own teachings.

Accordingly, it is respectfully submitted that no prima facie basis for the rejection of the claims is established. Therefore, it is respectfully requested that the rejection be reconsidered and withdrawn, and that the application be allowed to issue.